

REMARKS

The Examiner rejected claims 1-10 and 13-16 under 35 U.S.C. § 102(b) as being anticipated by Staas (U.S. Patent No. 6,047,499). The Examiner rejected claims 11, 12 and 17-20 under 35 U.S.C. § 103(a) as being unpatentable over Staas in view of Loran (U.S. Patent No. Des. 361,308). In response, the Applicant has amended the claims and has set forth arguments supporting the patentability of the claims over Staas and Loran. The Applicant believes the amendments made in response to the Examiner’s rejections have placed the application in position for allowance.

Amendments to Claims 1, 11, 12, 13, 15, 17, and 19

Applicant has amended claims 1, 11, 12, 13, 15, 17, and 19 to more clearly distinguish the present invention from the prior art. Specifically, Applicant is amending these claims as set forth below:

- a) claim 1 - amending this claim to incorporate the limitations of claim 2 regarding the upwardly facing surface being concave;
 - b) claim 11 - amending this claim to describe the function of the stabilizer members as supporting the center of the bottom higher than its periphery, as previously set forth in claim 12;
 - c) claim 12 - amending this claim to describe the stabilizer members as being in a generally circular pattern, with the inner stabilizer member being disposed generally inwardly of the outer stabilizer member, as shown in FIG. 7 of the drawings;
 - d) claim 13 - amending this claim to incorporate the limitations of claim 17 (prior to this amendment) regarding the downwardly facing surface of the bottom having one or more stabilizer members configured to support the center of the bottom higher than its periphery;
 - e) claim 15 - amending this claim to more specifically describe the upper supports as being generally inclined downward toward the center of the bottom;
 - f) claim 17 - amending this claim to delete the language incorporated into claim 13 and add language describing the stabilizer members comprising at least an inner and an outer stabilizer

RESPONSE/AMENDMENT

Appl. # 10/656,714

1 member that are in a generally circular pattern, with the inner stabilizer member being disposed
2 generally inwardly of the outer stabilizer member, as shown in FIG. 7 of the drawings; and

3 g) claim 19 - amending this claim to more specifically describe the upper supports as being
4 generally inclined downward toward the center of the bottom.

5

6 New Claim 21

7 Claim 21 adds the limitation to independent claim 18 that the stabilizer members
8 comprising at least an inner and an outer stabilizer member that are in a generally circular pattern,
9 with the inner stabilizer member being disposed generally inwardly of the outer stabilizer member, as
10 shown in FIG. 7 of the drawings.

11

12 Rejection under 35 U.S.C. § 102(b)

13 With regard to the rejection of claims 1-10 and 13-16 under 35 U.S.C. § 102(b) as
14 being anticipated by Staas, the Applicant respectfully disagrees with the Examiner (the claims as
15 amended herein). Staas does not disclose each and every element of Applicant's claimed invention as
16 required for a Section 102(b) rejection. (Lindemann Maschinenfabrik GMBH v. American Hoist &
17 Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984); W.L. Gore & Associates, Inc. v. Garlock, Inc.,
18 220 USPQ 303, 313 (Fed. Cir. 1983).) In particular, Staas does not disclose the use of a bottom
19 having an upwardly facing surface that is generally concave to facilitate the flow of fluids to the inlet
20 of the drainage orifice or inclined upper supports.

21 Staas discloses a saucer for a potted plant container 30 that supports the bottom 31 of
22 container 30 on a plurality of radially extending reinforcement ribs 18 (of which three are shown in
23 the figures) on its bottom wall 16. A tube 42 is hydraulically connected to the reservoir 11 formed
24 inside the saucer 10 and is moveable from an upper position that prevents drainage of water through
25 the tube and a lower position which allows controlled discharge of water from the reservoir 11
26 through the tube 42. Figure 2, referenced by the Examiner, shows the container 30 sitting on ribs

27 RESPONSE/AMENDMENT

Appl. # 10/656,714

1 18a and 18b. The Examiner takes the position that the bottom wall 16 (i.e., Applicant's upwardly
2 facing surface) is generally concave to facilitate the flow of fluids in the reservoir 11 to the inlet of
3 the orifice (i.e., opening 43 in Staas) and that ribs 18 are generally inclined downward to the center of
4 the bottom wall 16, referencing numeral 18a in Fig. 2). Applicant respectfully disagrees with the
5 Examiner's interpretation of the bottom wall 16 being concave and the ribs 18 being inclined
6 downward toward the center of the bottom wall 16.

7 As set forth in Applicant's specification (i.e., at page 16, lines 1-15), the upwardly
8 facing surface is configured to be concave to facilitate the drainage of water from the reservoir to the
9 inlet of the orifice in order to prevent water from sitting inside the reservoir. As discussed in the
10 Background section of the specification (i.e., page 3, line 10 through page 4, line 4), water left
11 standing in the drainage tray below a potted plant is known to create a breeding ground for mosquitos
12 and other pests and, due primarily to fertilizers and/or other chemicals, create a smell nuisance. In
13 addition, water left standing in the drainage tray creates the potential for overflow, which can stain a
14 person's deck, patio, sidewalk or other areas and cause a slip/fall hazzard. In contrast, Applicant's
15 invention is configured specifically to drain the water away from the drainage tray to an area where
16 water will not be left standing or slip hazards created. A concave bottom facilitates the substantially
17 complete drainage of the water. With problems such as the West Nile Virus being or becoming
18 somewhat prevalent in certain areas, it is particularly important to drain away the water that flows
19 from the potted container. In contrast, Staas is not concerned with keeping water drained out of the
20 drainage tray or saucer. In fact, at column 3, lines 5-10, the patentee states that the reservoir retains
21 "the excess water so that it can be reabsorbed into the soil within the pot 30, as required," clearly
22 indicating that the invention can be utilized to retain water in the reservoir. Later, at column 3, lines
23 44 through 56, the patentee states "[s]ince it is normally desired that a level of water be retained in
24 the reservoir 11 ...," further indicating that the Staas, in contrast to the present invention, is not
25 concerned with draining away virtually all of the water out of the reservoir. Further, Figure 2 of
26 Staas does not show a concave surface for bottom wall 16, instead the bottom wall is shown as flat or

27 RESPONSE/AMENDMENT

Appl. # 10/656,714

1 horizontal, with no real means to facilitate improved flow of fluid to the discharge orifice 43. The
2 specification of Staas does not discuss the need or desirability of providing a concave bottom to
3 facilitate drainage of water from the drainage tray or saucer. As such, Applicant believes that Staas
4 does not anticipate claim 1, as amended, of the present application.

5 With regard to the inclined ribs, Applicant describes (at page 18, line 18 through page
6 19, line 1) the benefit of having an inclined upper supports or ribs to better support different sized
7 pots inside the drainage tray. While Staas does show use of ribs on the bottom wall of the saucer, the
8 purpose of the ribs is described (column 2, line 62 through column 3, line 5) as elevating the bottom
9 31 of container 30 to facilitate water draining from the container to the saucer. While this is also a
10 purpose of Applicant's upper supports, Applicant's upper supports are further described as inclined to
11 better support different sized pots inside the drainage tray. In contrast, the ribs 18 of Staas are not
12 described as being inclined and are not shown as inclined in the drawings, particularly Fig. 2. In Fig.
13 2, the ribs on which container 30 sits are shown as being flat or horizontal. As such, Applicant
14 believes that Staas does not anticipate claim 5, 15 and 19 (claims 15 and 19 as amended) of the
15 present application.

16 In order to serve as a reference under 35 U.S.C. § 102(b), the reference must be
17 enabling as to the features to which anticipation is suggested. (Akzo N.V. v. U.S. Int'l Trade Comm.,
18 1 USPQ2d 1241, 1245 (Fed. Cir. 1986); In re Donohue, 226 USPQ 619, 621-22 (Fed. Cir. 1985);
19 W.L. Gore & Associates, Inc., 220 USPQ at 314.) Anticipation cannot be predicated on mere
20 conjecture regarding the characteristics of various features of the invention disclosed in the reference.
21 (See W.L. Gore & Associates, Inc., 220 USPQ at 314.) With regard to Applicant's invention, Staas
22 is non-enabling as to a concave bottom or inclined ribs, because the bottom and ribs do not function
23 to accomplish the objectives of Applicant's invention (as set forth above). There is no suggestion in
24 Staas that the saucer be provided with a concave bottom to facilitate drainage out of the saucer or
25 inclined ribs to better accept different sized containers inside the saucer, as with Applicant's drainage
26 tray of the present invention.

27 RESPONSE/AMENDMENT

Appl. # 10/656,714

1 Rejection under 35 U.S.C. § 103(a)

2 With regard to the obviousness rejections for Applicant's claims, which are based on
3 Staas in light of Loran, Section 103(a) only denies patentability to those inventions whose "subject
4 matter as a whole would have been obvious at the time the invention was made to a person having
5 ordinary skill in the art to which said subject matter pertains." (35 U.S.C. § 103.) Initially,
6 Applicant believes that the teachings from Loran are not reasonably pertinent to the problems solved
7 by Applicant's invention. (See In re Clay, 23 USPQ2d 1058, 1060 (CAFC 1992).) Although Loran
8 is a pedestal support configured as a saucer or tray, Loran is directed to a pedestal support saucer that
9 is configured with a plurality of downwardly projecting members for, presumably, insertion into the
10 ground to better support the tray and pedestal which sits on or in the tray. The invention of Loran,
11 however, is not directed to a saucer that is configured to drain away water from the reservoir inside
12 the saucer, which is the subject matter of Applicant's invention. Because the subject matter and
13 purpose of Applicant's invention is different than the subject and purpose of the invention in Loran,
14 an inventor would not have been motivated to look to or consider this patent in attempting to solve the
15 problems solved by Applicant's invention. (See In re Clay, 23 USPQ2d at 1061.) As a result, a
16 person having ordinary skill in the art would not apply the teachings of Loran, or combine those
17 teaching with those of Staas, to arrive at Applicant's invention and nothing in either Staas or Loran
18 suggests such an application, particularly in light of the differences between Loran and Applicant's
19 invention (also Staas).

20 Even if the Loran reference is analogous art, respectfully, nothing suggests combining
21 the teachings of Loran with Staas or with knowledge commonly known in the art, in any combination
22 suggested by the Examiner, to arrive at Applicant's invention. As stated by the court in In re Geiger,
23 2 USPQ2d 1276 (CAFC 1987), "[o]bviousness cannot be established by combining the teachings of
24 the prior art to produce the claimed invention, absent some teaching, suggestion or incentive
25 supporting the combination." (In re Geiger, 2 USPQ2d at 1278.) The motivation or suggestion to
26 combine references must exist, otherwise the determination of obviousness involves nothing more

1 "than indiscriminately combining prior art." (Micro Chemical Inc. v. Great Plains Chemical Co., 41
2 USPQ2d 1238, 1244 (CAFC 1997).) In In re Fritch, 23 USPQ2d 1780 (CAFC 1992), the Federal
3 Circuit stated the following:

4 In proceedings before the Patent and Trademark Office, the Examiner bears the burden of
5 establishing a prima facie case of obviousness based upon the prior art. The Examiner can
6 satisfy this burden only by showing some objective teaching in the prior art or that knowledge
generally available to one of ordinary skill in the art would lead that individual to combine the
relevant teachings of the references.

7 Obviousness cannot be established by combining the teachings of the prior art to produce the
8 claimed invention, absent some teaching or suggestion supporting the combination. Under
9 section 103, teachings of references can be combined *only* if there is some suggestion or
10 incentive to do so. Although couched in terms of combining teachings found in the prior art,
the same inquiry must be carried out in the context of a purported obvious "modification" of
the prior art. The mere fact that the prior art may be modified in the manner suggested by the
Examiner does not make the modification obvious unless the prior art suggested the
desirability of the modification.

11 Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is
12 impermissible to use the claimed invention as an instruction manual or "template" to piece
13 together the teachings of the prior art so that the claimed invention is rendered obvious. This
court has previously stated that one cannot use hindsight reconstruction to pick and choose
14 among isolated disclosures in the prior art to deprecate the claimed invention. (In re Fritch,
23 USPQ2d at 1783-84 (internal quotes and citations removed).)

15 Respectfully, nothing in either the Loran or Staas references, or any knowledge
16 generally available to one of ordinary skill in the art, compels, teaches, suggests or even offers any
17 incentive such that an individual wanting to have a saucer or drainage tray suitable for draining away
18 water that drains from a potted plant in the manner of Applicant's invention would combine the
19 teachings from Staas with Loran, as suggested by the Examiner. (See In re Fritch, 23 USPQ2d at
20 1783; In re Geiger, 2 USPQ2d at 1278.) The design patent of Loran appears to be directed at a
21 pedestal support saucer or tray that has a plurality of spiked members on the bottom that appear to be
22 suitable for placement in the ground. The stabilizer members of claims 11, 12, 13 (as amended), 17-
23 20 and 21 (new claim) are configured to support the center of the bottom higher than the periphery of
24 the bottom. As set forth in Applicant's specification (at page 19, line 6 through page 20, line 7), the
25 stabilizer members facilitate the concave configuration of the bottom, discussed above, and the
26 drainage of water out of and away from Applicant's drainage tray. As shown in the figures of Loran,

1 particularly Fig. 3, the projectiles of Loran are not configured so as to support the center of the
2 saucer's bottom higher than its periphery. In fact, Fig. 3 shows the projectiles as being of the same
3 length, creating a horizontally displaced saucer. There is no suggestion in Loran to configure these
4 projectiles so as have the center of the tray higher than its periphery. A person wanting to solve the
5 problem solved by Applicant's invention (i.e., a drainage tray for potted plants that beneficially drains
6 water away from the potted plant and the drainage tray) would not look to a reference directed at
7 saucer having a plurality of evenly disposed projectiles, which presumably are for insertion into the
8 ground, for direction on how to facilitate the drainage away from the drainage tray (which the
9 stabilizer members of Applicant's invention are configured to accomplish). Even if a person skilled
10 in the art did look to Loran, Loran does not teach or suggest a solution to the problems solved by
11 Applicant's invention. Viewing the Loran reference and determining that it would have been obvious
12 to combine it with Staas to achieve Applicant's invention may be an application of impermissible
13 hindsight to arrive at the determination of obviousness. (See In re Fritch, 23 USPQ2d at 1784.) As
14 stated above, nothing in either the Staas or Loran patents suggest, compel or offer any incentive to
15 provide a drainage tray having one or more stabilizer members on the bottom that are configured to
16 support the center of the bottom higher than its periphery. As such, Applicant's claims are not
17 obvious in light of Staas and Loran.

18 In light of the above arguments, Applicant respectfully requests the Examiner to
19 withdraw the rejection of the claims set forth in the subject patent application.

20 Applicant's original application included fees for three independent claims and a total
21 of twenty claims. One claim is cancelled and one claim is added by this amendment and, therefore,
22 no additional fees are required. After this amendment, a total of twenty claims, including three
23 independent claims are pending in this application.

24 ///

25 ///

26 ///

27 RESPONSE/AMENDMENT

Appl. # 10/656,714

1 In view of the foregoing, it is submitted that this application is in condition for
2 allowance. Reconsideration of the rejections and objections in light of this Amendment is requested.
3 Applicant believes that the amended claims are in condition for allowance. Allowance of claims 1 and
4 3-21 is respectfully solicited.

5

6 Dated: July 19, 2004

7 Respectfully Submitted,

8 By 
9 Richard A. Ryan
10 Reg. No. 39,014

11 Ryan & Engnath
12 8469 N. Millbrook, Suite 104
13 Fresno, CA 93720

14 Phone: (559) 447-1862
15 Fax: (559) 447-1042
16 e-mail: richard@ryanengnath.com